

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES DUNMAN

Appeal 2007-0293
Application 10/630,982
Technology Center 1700

Decided: February 28, 2007

Before CHUNG K. PAK, THOMAS A. WALTZ, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the Primary Examiner's non-final rejection of claims 1 through 11 and 13 through 20, which are the only claims pending in this application (*see* the Office action dated Nov. 21, 2005). Although the Examiner's rejection was not made final, we have jurisdiction since the claims have been twice examined and rejected. *See Ex parte Lemoine*, 46 USPQ2d 1420, 1423 (Bd. Pat. App. & Int. 1998); 35 U.S.C. § 134 (2002).

According to Appellant, the invention is directed to a method of protecting portions of containers from being coated while other portions of the containers are coated (Br. 7). The method includes the steps of making the containers from a first material, coating the containers with a second material, and, prior to coating, covering the portions of the container that should remain uncoated with shields of the first material, where the shields are made from scraps of the first material used to make the container (*id.*). Claim 1 is illustrative of the invention and is reproduced below:

1. A method of protecting portions of containers from being coated while other portions of the containers are being coated, comprising:

making containers from a first material;

coating the containers with a second material; and

prior to coating, covering portions of the containers to remain uncoated with shields of the first material,

wherein the shields are made from scraps of the first material produced from the making of the containers.

In addition to Appellant's admitted prior art (hereafter APA), the Examiner relies on the following references as evidence of obviousness:

Carl	US 3,740,259	Jun. 19, 1973
White	US 4,667,620	May 26, 1987

ISSUES ON APPEAL

Claims 17-20 stand rejected under the first paragraph of 35 U.S.C. § 112, first paragraph, for failure to meet the written description requirement (Answer 3).¹

Claims 1-4, 6, 8-11, 15, and 16 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Carl in view of White (Answer 4).² Claims 5, 7, 13, and 14 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Carl in view of White and the APA (Answer 6).

Appellant contends that Figure 1 provides support for added claims 17-20, with the only portion of the shield 10 that engages container 18 being shoulder 10d, but this shoulder does not engage the threaded portion of the container (Br. 11).

Appellant contends that the Examiner agrees that Carl does not teach that the main body member 10 is made from scraps of the first material used to make the container, and the Examiner has not provided any reason or motivation to modify Carl or combine the disclosures of Carl and White (Br. 12-13).

Appellant also contends that the discussion in White of recycling is made in the context of describing disadvantages of dip-coating techniques, and is not applicable to the claimed process (Br. 13).

¹ We refer to and cite from the “edited version” of the Examiner’s Answer dated Aug. 24, 2006.

² The Examiner has mistakenly included claim 12 in this rejection (Answer 4). However, as correctly noted by Appellant (Br. 5), claim 12 was canceled in the Amendment dated May 23, 2005.

The Examiner contends that the “exploded view” of Appellant’s Figure 1 shows that the lower section of the upper shield engages and holds container 18 in view of the overlapping contact (Answer 7).

The Examiner contends that one of ordinary skill in the art would have been aware of the pervasive recycling of plastic scrap to reduce waste and enhance cost-effectiveness of plastic resources, as evidenced by White, and used any scrap material to make a shield of the same material (Answer 7-8).

Accordingly, the dispositive issues in this appeal are as follows: (1) does Figure 1 provide support for added (non-original) claims 17-20?; and (2) would it have been within the ordinary skill in this art to have recycled scrap plastic from making the container to form the shield, where the shield was known to be made from the same material as the container?

We determine that the Examiner has established that Figure 1 does not provide sufficient support for the language recited in added (non-original) claims 17-20. We also determine that the Examiner has established a prima facie case of obviousness in view of the reference evidence, which Appellant has not adequately rebutted by their arguments. Therefore we AFFIRM all rejections in this appeal essentially for the reasons stated in the Answer, as well as those reasons set forth below.

OPINION

A. The Rejection under § 112, ¶ 1

The Examiner finds that claims 17-20 recite “the shields do not hold a threaded engagement portion of a finish of the containers” and this language

fails to find support in the original disclosure (Answer 3 and 7). Appellant relies on original Figure 1 as support for this language in claims 17-20 (Br. 11).

If the Examiner establishes that Appellant claims embodiments that are completely outside the scope of the specification, then the Examiner has met the initial burden of proof. *See In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996). The drawings alone may provide “written description” of the invention as required by the first paragraph of § 112. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1565, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991); *Ex parte Holt*, 19 USPQ2d 1211, 1213 (Bd. Pat. App. & Int. 1991).

Appellant agrees with the Examiner that shoulder 10d of shield 10 engages or “holds” the container 18, but argues that this portion engages only the top of the container, not the threaded engagement portion (Br. 11; *see* the Answer 7). However, as clearly seen in the “exploded view” of Figure 1 attached to the Answer, we agree with the Examiner that the lower section of the upper shield “engages and holds” by virtue of the overlapping contact of the shield shoulder and the top portion of the threaded portion of container 18 (Answer 7). Accordingly, we do not find any support in Figure 1 for the exclusionary language recited in claims 17-20 on appeal. We note that Appellant has not disputed the Examiner’s analysis of the “exploded view” of Figure 1.

For the foregoing reasons and those stated in the Answer, we determine that the Examiner has established a prima facie case of lack of

“written description” under § 112, ¶ 1, which Appellant has not adequately rebutted. Therefore we affirm the Examiner’s rejection of claims 17-20 under 35 U.S.C. § 112, first paragraph, for failure to meet the “written description” requirement.

B. The Rejections based on § 103(a)

We determine the following factual findings from this record:

- (1) Carl disclose a method for masking [shielding] a portion of a container to prevent the coating of this portion while permitting the coating of the remaining surface of the container (abstract; Answer 4);
- (2) Carl teaches that the container may be made from various compositions such as ceramics, glasses, and polymers such as polyethylene, polypropylene, and polyvinyl chloride (col. 1, ll. 46-48; Answer 4);
- (3) Carl discloses that the body member or chuck 10 masks or shields a portion of the container 12 from the coating (col. 4, ll. 16-19; Answer 4);
- (4) Carl discloses that the body member or chuck 10 may be made from “plastic materials such as bakelite, high density polyethylene, phenolic oxidative coupling polymers, and the like” (col. 2, l. 61-col. 3, l. 1; Answer 4);
- (5) White discloses coating portions of a plastic container while shielding other portions from the coating material (Figure 2 and col. 56-59; Answer 5);

(6) White teaches that, in the food and beverage industry, the trend is to move away from glass and metal containers and turn to plastic containers, most preferably polyethylene terephthalate (PET) (col. 1, ll. 13-19; Answer 5); and

(7) White teaches that “[i]n light of the trend toward compulsive container return laws in various states and a probable federal deposit/return law, all future container designs must be quickly and easily recyclable” (col. 1, l. 66-col. 2, l. 1).

“When relying on numerous references or a modification of prior art, it is incumbent upon the examiner to identify some suggestion to combine references or make the modification. [Citation omitted].” *In re Mayne*, 104 F.3d 1339, 1342, 41 USPQ2d 1451, 1454 (Fed. Cir. 1997). A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, but may be implicit. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (internal citations omitted).

With regard to claim 1 on appeal, the only claimed step that Appellant argues is the last step, namely that Carl does not teach that the main body member 10 [the shield] is made from scraps of the first material used to make the container (Br. 13). As found above, Carl teaches that the same

material may be used for both the container and the main body member [shield]. We determine that the Examiner has identified an implicit motivation for the modification of Carl, namely that one of ordinary skill in this art would have been motivated by the well-known use of recycling and economic sense to have used any scraps of plastic material leftover from the container formation in the making of the shield of the same plastic material (Answer 7-8).³ It is well established that economics alone can provide the motivation or suggestion to modify a reference. *See In re Clinton*, 527 F.2d 1226, 1229, 188 USPQ 365, 367 (CCPA 1976). Recycling has also been recognized as a cost-effective measure. *See In re Marsheck*, 438 F.2d 606, 608-09, 168 USPQ 721, 723 (CCPA 1971). Therefore, especially in view of the teachings of White regarding the trend of recycling plastics in the container art, we determine that the Examiner has met the initial burden of identifying the reason or suggestion to modify the process of Carl to yield the claimed subject matter.

With regard to claim 15, Appellant argues that Carl fails to disclose that the main body member 10 is removably held on a conveyor, let alone by a friction fit (Br. 14). With regard to claim 16, Appellant additionally argues that Carl does not disclose that the chuck 10 is capable of being disposed of during a shutdown (Br. 15).

³ There is no dispute that “recycling” includes recycling of scraps (Answer 8).

As can readily be seen from Figures 4 and 5 of Carl, the main body member 10 is removably held on conveyor 25 by a “friction fit” with support means 21 (col. 4, ll. 1-12). Of course, the chuck or main body member 10 is capable of being removed (and disposed of if necessary) during any shutdown (Answer 9-10).

With regard to the separate rejection of claims 5, 7, 13, and 14 (Answer 6), Appellant merely repeats the arguments set forth above (Br. 15). Accordingly, we adopt our remarks as noted above.

For the foregoing reasons and those stated in the Answer, we determine that the Examiner has established a prima facie case of obviousness in view of the reference evidence. Based on the totality of the record, including due consideration of Appellant’s arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of § 103(a). Therefore we affirm both grounds of rejection in this appeal based on § 103(a).

C. Summary

The rejection of claims 17-20 under 35 U.S.C. § 112, first paragraph, is affirmed.

The rejection of claims 1-4, 6, 8-11, 15, and 16 under 35 U.S.C. § 103(a) over Carl in view of White is affirmed. The rejection of claims 5, 7, 13, and 14 under 35 U.S.C. § 103(a) over Carl in view of White and the APA is also affirmed.

The decision of the Examiner is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

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